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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,067	07/10/2000	Mitsuru Nagasaka	450100-02611	9087

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2421

MAIL DATE	DELIVERY MODE
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10/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/613,067	<b>Applicant(s)</b> NAGASAKA ET AL.	
	<b>Examiner</b> Hoang-Vu A. Nguyen-Ba	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2008 has been entered.
2. Claims 1-13 remain pending. Claims 1, 6, 11, 12 and 13 are independent claims.

### ***Response to Amendments***

3. Per Applicants' request, Claims 1, 6, 11, 12 and 13 have been amended.
4. The objection to the title is withdrawn in view of Applicants' amendment to the title to make it more clearly indicative of the invention to which the claims are directed.
5. The rejection of Claim 13 under 35 U.S.C. § 112, second paragraph is withdrawn in view of Applicants' amendments to the claim to delete the clause "adapted to" which rendered the claim vague and indefinite.

### ***Response to Arguments***

6. Applicants' arguments in the Remarks section (pp. 14-17) of the Amendment filed June 13, 2008 have been fully considered and they are persuasive. The rejection of Claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over the combination Williams-Schein-Anderson is withdrawn.

### ***Claim Objections***

7. Claim 1 is objected to because of the following informality: Claim 1 contains a typographical error at line 16: the limitation – image, – should be inserted after “(a) the first”.

***Double Patenting***

8. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1993); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Voge*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.103(c) 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.37(b).

9. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 8 of U.S. Patent No. 7,379,655 to Koyabu et al. (“Koyabu”).

<b>Instant Claim 2</b>	<b>Patent Claim 8</b>
<i>An information receiving apparatus for receiving headline information related to information, comprising:</i>	An information retrieving apparatus configured to retrieve contents that is provided by a content provider, comprising:
<i>memory means for storing user preference information</i>	an usage history generator configured to generate and update an usage history of the content that is provided by the content provider, based on recording of the content to a storage or based

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	on reproducing recorded content from the storage;
<i>means for detecting reception of a plurality of headline information related to the information</i>	a retrieving unit configured to retrieve content on a basis of said usage history;
<i>means for searching, based on said user preference information stored in said memory means, headline information coincided with said user preference information among received headline information at the time when the reception of said plurality of headline information is detected by said detecting means</i>	content guide generator configured to generate a list of the retrieved content; and a content guide processor configured to process the list of retrieved content on a basis of said usage history to generate a content guide that fits into a display screen
<i>means for generating a first image corresponding to the user preference information,</i>	
<i>means for generating a search condition setting image corresponding to a user set search condition</i>	
<i>means for generating a second image corresponding to a search result</i>	
<i>means for superimposing either: (a) the first image, the search condition setting image, and the second image or (b) the first image or the search condition setting image and the second image over a current video signal;</i>	
<i>wherein the means for superimposing</i>	

<i>superimposes (a) or (b) over a current video signal;</i>	
<i>wherein said user preference information includes a plurality of registration patterns</i>	
<i>wherein the registration pattern is pre-selected information corresponding to an event and a timing of the event and limits the headline information that is to be searched</i>	
<i>wherein one of the plurality of registration patterns is selected first by a user, preceding a selection of corresponding search criteria</i>	
<i>wherein results of searching based on said user preference information are a function of the selected registration pattern combined with the selection of corresponding search criteria</i>	
<i>display means for displaying said headline information searched by said searching means.</i>	to display the content guide at a same time, when the content guide based on the entire list of retrieved content cannot be displayed in the display screen at the same time.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent Claim 8 appears to be anticipated by instant Claim 2. As can be seen from the table, all the features recited in Patent Claim 8 are recited in instant Claim 2.

Claims 7 (6+7), 11, 12 and 13 are also rejected as being unpatentable over claim 8 of Koyabu for the same reasons discussed above.

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All the dependent claims which incorporate the features of the instant claims 1 and 6 are also rejected for the same reasons.

***Allowable Subject Matter***

10. The prior art of record, taken individually or in combination, fails to teach or suggest at least the following features recited in independent claims 1, 5 and 10, when these features are considered in the context of these independent claims:

*means for superimposing either:*

*(a) the first image, the search condition setting image, and the second image, or*

*(b) the first image or the search condition setting image and the second image;*

*wherein the means for superimposing superimposes (a) or (b) over a current video signal.*

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A. Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday -Friday from 7:00 – 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist: 571-272-2600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/  
Primary Examiner, Art Unit 2421

October 20, 2008